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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,844	11/23/1998	GAD JANAY	030	1758

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EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/197,844

Applicant(s)

JANAY, GAD

Examiner

CESAR B PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application filed on 11/23/98.

This action is made Final.

2. Claims 5-14 have been added. Claims 1-14 are pending in the case. Claims 5, and 10-11 are an independent claim.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 still recites the limitation "copies of said document" in line 2. There is insufficient antecedent basis for this limitation in independent claim 1, because such "document" is not found in claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoda (Pat.# 5,890,173, 3/30/99, filed 11/20/96).

Regarding independent claim 1, Yoda discloses a “link information extraction unit” for intercepting document link data in a document sent to a printer. This unit retrieves documents associated with the link data from a web database and prints both the intercepted link data (from a print storage) and the associated data received from the database (col.3, lines 10-40, col. 5, lines 1-col.6, line 67). Yoda fails to explicitly disclose *a print spool*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the print spool, because Yoda teaches above the interception, and storage of a print job after the printing selection has been issued, and is awaiting to be printed.

Regarding claim 2, which depends on claim 1, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-40, and col.5, lines 52-col.7, line 67).

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoda in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

Regarding claim 3, which depends on claim 1, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-

40, and col.5, lines 52-col.7, line 67). Yoda fails to explicitly disclose *documents which are similar and differ only by certain information derived from a database look-up*. Ikenoue teaches the embedding of additional data about a document, retrieved from a database, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Yoda, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 4, which depends on claim 3, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-40, and col.5, lines 52-col.7, line 67). Yoda fails to explicitly disclose *whether or not information is confidential*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Yoda, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

9. Claims 5-11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95).

Regarding independent claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information (col.3, line 7-col.4, line 21, col.6, lines 1-67, and col.8, lines 1-

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67). Warmus fails to explicitly disclose *a print spool*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the print spool, because Warmus teaches above the interception, and storage of a print job after the printing selection has been issued, and is awaiting to be printed.

Claim 6 is directed towards a formatting tool for implementing the tool of claim 5, and therefore is similarly rejected.

Regarding claim 7, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information in a double-side printing format (col.3, line 7-col.4, line 21, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67).

Claims 8-11, and 13-14 are directed towards a formatting tool for implementing the tool of claims 6, 6, and (5 & 9), 5, 5, and 5, and therefore are similarly rejected.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over of Warmus et al, hereinafter Warmus, in view of Ikenoue.

Regarding claim 12, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 21, col.6, lines 1-67, and col.7,line1-col.8, lines 1-67). Warmus fails to explicitly disclose *second portion is a confidential portion*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person

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of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Response to Arguments

11. Applicant's arguments with respect to claims 6-7, 10, and 11 have been considered but are moot in view of the new ground(s) of rejection. The Applicant submit that neither Yoda, nor Ikenoue teach the addition of different data content (p.4, lines 8-22). The Applicants are referred to the rejection of these newly added claims as outlined above.

Furthermore, the Applicant submit that neither Yoda, nor Ikenoue teach or suggest the printing of multiple copies including the same part and a different part (p.4, lines 8-18). The Applicants are referred to the rejection of these newly added claims as outlined above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Warmus et al. (Pat. # 6,332,149), and Hatrick et al. (Pat. # 5,532,920).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office
Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)

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- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

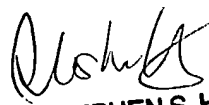
Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “**PROPOSED**” or “**DRAFT**”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

6/28/02


STEPHEN S. HONG
PRIMARY EXAMINER